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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCOGGIE,
MICHAEL E. KACABA,
DAVID A. ROCHON, and
DAVID M. DIAMOND

Appeal 2008-004478
Application 09/401,939
Technology Center 3600

Decided: April 30, 2010

22 Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
23 MOHANTY, *Administrative Patent Judges*.
24 FETTING, *Administrative Patent Judge*.

25 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Michael C. Scoggie, Michael E. Kacaba, David A. Rochon, and David
3 M. Diamond (Appellants) seek review under 35 U.S.C. § 134 (2002) of a
4 final rejection of claims 32-76, the only claims pending in the application on
5 appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
7 (2002).

8 SUMMARY OF DECISION¹

9 We AFFIRM-IN-PART.

10 THE INVENTION

11 The Appellants invented ways of delivering customer incentives and
12 other shopping aids to customers with a computer network (Specification
13 1:6-8).

14 An understanding of the invention can be derived from a reading of
15 exemplary claims 32 and 33, which are reproduced below [bracketed matter
16 and some paragraphing added].

17 32. A computer implemented method for distributing
18 purchasing incentives to consumers, comprising:

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.", filed May 20, 2008) and the Examiner's Answer ("Ans.", mailed February 27, 2007), and Final Rejection ("Final Rej.", mailed August 11, 2006).

1 [1] transmitting promotion data identifying a plurality of
2 product discounts
3 from a main computer
4 to a personal computer
5 over a computer network;
6 [2] displaying said plurality of product discounts
7 at said personal computer
8 based on said promotion data;
9 [3] transmitting selection data
10 designating at least one product discount
11 selected from said plurality of product discounts from
12 said personal computer to said main computer
13 over said computer network;
14 [4] generating token data
15 depending on said selection data;
16 [5] transmitting said token data
17 from said main computer
18 to said personal computer
19 over said computer network;
20 [6] identifying said token data
21 in a retail store
22 in association with items being purchased at said retail
23 store;
24 [7] determining discount items being purchased
25 corresponding to said at least one product discount from
26 said identified token data; and
27 [8] generating a purchase incentive
28 based on said discount items.

29 33. The method of claim 32,

1 wherein generating said purchase incentive comprises
2 generating an instantly redeemable voucher.

THE REJECTIONS

4 The Examiner relies upon the following prior art:

Nichtberger US 4,882,675 Nov. 21, 1989

Barnett US 6,321,208 B1 Nov. 20, 2001

5 Claims 32, 33, 35-46, 48-59, 61-71, and 75 stand rejected under 35
6 U.S.C. § 102(b) as anticipated by Nichtberger.

7 Claims 34, 47, and 60 stand rejected under 35 U.S.C. § 103(a) as
8 unpatentable over Nichtberger.

9 Claims 72-74 and 76 stand rejected under 35 U.S.C. § 103(a) as
10 unpatentable over Nichtberger and Barnett.

ARGUMENTS

Claims 32, 33, 35-46, 48-59, 61-71, and 75 rejected under 35 U.S.C. § 102(b) as anticipated by Nichtberger.

14 Claims 32-44 are method claims; claims 45-57 are system claims; and
15 claims 58-70 are computer media claims. Each of these sets generally
16 parallels the other two, hence the Appellants argue the first set, and those
17 arguments apply to the corresponding claims in the other sets as well. The
18 Appellants argued independent claim 32, and dependent claims 33, 41, 42,
19 and 44. They argue that Nichtberger does not describe using a personal
20 computer (claim 32); a voucher (claim 33); a discount on the basis of usage
21 frequency (claims 41 and 42); and an intranet or Internet (claim 44).

3 The Appellants apply their argument regarding the lack of a voucher
4 from claim 33 to claim 34 as well.

7 The Appellants argue the Examiner has not shown any motivation to
8 combine the references.

ISSUES

10 The issue of whether the Examiner erred in rejecting claims 32, 33, 35-
11 46, 48-59, 61-71, and 75 under 35 U.S.C. § 102(b) as anticipated by
12 Nichtberger turns on whether Nichtberger anticipates the claimed personal
13 computer, voucher, usage frequency discount, and intranet.

14 The issue of whether the Examiner erred in rejecting claims 34, 47 and
15 60 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger turns on the
16 resolution to the rejection of claim 33.

17 The issue of whether the Examiner erred in rejecting claims 72-74 and
18 76 under 35 U.S.C. § 103(a) as unpatentable over Nichtberger and Barnett
19 turns on whether it was predictable for one of ordinary skill to apply
20 Barnett's to Nichtberger's system.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Claim Construction

01. The disclosure contains no lexicographic definition of "personal computer."

02. The ordinary and customary meaning of “personal computer” is a computer built around a microprocessor for use by an individual.²

03. The disclosure contains no lexicographic definition of
“voucher.”

04. The ordinary and customary meaning of “voucher” is a piece of substantiating evidence.²

Facts Related to the Prior Art

Nichberger

05. Nichtberger is directed to distribution, redemption and clearing of coupons and the like, and in particular how coupons (such as, cents-off merchandise coupons) can be distributed, redeemed and cleared electronically. (Nichtberger 1:6-11).

06. Nichtberger describes how a customer can select product discount promotions at a computer and then the selected

² American Heritage Dictionary of the English Language (4th ed. 2000).

1 promotions are displayed at checkout during a sale. Nichtberger
2 Summary Of The Invention: 1:58-2:6.

3 07. Nichtberger's computer used for discount selection is used by a
4 customer (Nichtberger Coupon Distribution and Redemption
5 Summary 10:50 – 11:45) and has a microprocessor as its
6 computing unit (Block diagram of the computer in Nichtberger
7 Fig. 5).

8 08. A receipt may be printed by Nichtberger for the user's
9 convenience, identifying the selected coupons. Nichtberger: 5:15-
10 16.

11 09. Nichtberger describes a communications link, but does not
12 describe the topology or the protocols employed in the link.
13 Nichtberger: 11:46-50.

14 *Barnett*

15 10. Barnett is directed to distributing and generating, at remote-site
16 product redemption coupons. Barnett: 4:40-44.

17 PRINCIPLES OF LAW

18 *Anticipation*

19 "A claim is anticipated only if each and every element as set forth in the
20 claim is found, either expressly or inherently described, in a single prior art
21 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
22 631 (Fed. Cir. 1987). "When a claim covers several structures or
23 compositions, either generically or as alternatives, the claim is deemed
24 anticipated if any of the structures or compositions within the scope of the

1 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
2 Cir. 2001). "The identical invention must be shown in as complete detail as
3 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
4 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
5 the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology
6 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

7 *Obviousness*

8 A claimed invention is unpatentable if the differences between it and
9 the prior art are "such that the subject matter as a whole would have been
10 obvious at the time the invention was made to a person having ordinary skill
11 in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
12 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

13 In *Graham*, the Court held that that the obviousness analysis is
14 bottomed on several basic factual inquiries: "[1] the scope and content of
15 the prior art are to be determined; [2] differences between the prior art and
16 the claims at issue are to be ascertained; and [3] the level of ordinary skill
17 in the pertinent art resolved." *Graham*, 383 U.S. at 17. *See also KSR*, 550
18 U.S. at 406. "The combination of familiar elements according to known
19 methods is likely to be obvious when it does no more than yield predictable
20 results." *KSR*, 550 U.S. at 416.

21 ANALYSIS

22 *Claims 32, 33, 35-46, 48-59, 61-71, and 75 rejected under 35 U.S.C.*
23 *§ 102(b) as anticipated by Nichtberger.*

24 The independent claims essentially are for a customer to select product
25 discount promotions at a personal computer and then the selected

1 promotions are displayed at checkout during a sale. Nichtberger does this
2 with a computer (FF 06) and the Appellants do not dispute this. The sole
3 argument is that Nichtberger's computer is not a personal computer because
4 the Appellants contend that a personal computer must be personal to the user
5 and have email and internet connections. Appeal Br. 18.

6 The Specification does not define a personal computer. FF 01. Both the
7 Appellants and the Examiner offer constructions for consideration, but
8 absent further definition in the Specification, the construction is to be guided
9 by how one of ordinary skill would have understood the term. The ordinary
10 and customary meaning of "personal computer" is a computer built around a
11 microprocessor for use by an individual. FF 02. Nichtberger's computer is
12 built around a microprocessor for use by an individual. FF 07. Even if we
13 take the argument that a kiosk itself is not a personal computer, the
14 microprocessor and associated circuitry forming Nichtberger's computer
15 would be a personal computer within the kiosk. Nothing in claim 1 further
16 specifies the protocols used for information transmitted to and from the
17 personal computer, so arguments regarding email and internet connections
18 are simply not commensurate with the scope of the claim. Thus, we agree
19 with the Examiner that Nichtberger's computer is a personal computer.

20 The Appellants next argue that the coupon in Nichtberger is not a
21 voucher as in claim 33. Appeal Br. 19. The Appellants offer a definition of
22 a voucher as "a document that provides supporting evidence for a claim."
23 Appeal Br. 19. The Specification does not provide a definition. FF 03. The
24 ordinary and customary meaning of "voucher" is a piece of substantiating
25 evidence. FF 04. This is consistent with the Appellants' proffered
26 definition.

1 So, the issue is whether a coupon for a product discount, even a
2 paperless coupon, resident in a computer, is a document that provides
3 supporting evidence for a claim. Clearly, a product discount coupon is
4 evidence for the claim of a product discount. Certainly, documents can be
5 electronic in nature. Further, a receipt may be printed by Nichtberger for the
6 user's convenience, identifying the selected coupons. FF 08. This would be
7 a printed document evidencing the claims for product discounts.
8 Accordingly, we agree with the Examiner that Nichtberger's coupons are
9 vouchers and so Nichtberger describes claim 33.

10 The Appellants also argue claims 41, 42, and 44. As the Appellants
11 point out (Appeal Br. 22), the Examiner made no factual findings as to the
12 identifying a plurality of product discounts on a basis of a frequency of
13 usage of tokens by a consumer. We are unable to find any such description
14 in Nichtberger. Thus, we agree that the Examiner failed to present a prima
15 facie case of anticipation as to claim 41 and 42.

16 Claim 44 requires using the Internet or an intranet. Both the Internet and
17 an intranet use the same technological protocol of TCP/IP but each pertains
18 to a different network domain. The Appellants point out that the Examiner
19 made no showing that Nichtberger describes an intranet or the Internet, and
20 no showing of their technology. Appeal Br. 19.

21 The Examiner found that Nichtberger describes a communication link.
22 The Examiner implied that such a link was part of a LAN, WAN or intranet.
23 Ans. 6. However, although Nichtberger describes a communications link, it
24 does not describe the topology or the protocols employed in the link. FF 09.

1 Thus, we agree with the Appellants that the Examiner failed to present a
2 *prima facie* case of anticipation for the Internet or intranet of claim 44.

3 Claims 54, 55, 57, 67, 68, and 70 parallel claims 41, 42, and 44, and so
4 the Examiner failed to present a *prima facie* case as to those claims as well.
5 The remaining rejection as to the remaining claims stand with the rejection
6 as to the independent claims.

7 *Claims 34, 47 and 60 rejected under 35 U.S.C. § 103(a) as unpatentable*
8 *over Nichtberger.*

9 These claims also require a voucher as with claim 33. The Appellants
10 repeated their argument regarding a voucher from claim 33 *supra*, and we
11 find that argument equally unpersuasive here. The Appellants also argued
12 claims 71-76 (Appeal Br. 22), but these claims are not within the scope of
13 this rejection.

14 *Claims 72-74 and 76 rejected under 35 U.S.C. § 103(a) as unpatentable*
15 *over Nichtberger and Barnett.*

16 Barnett is directed to distributing and generating, at a remote site,
17 product redemption coupons. FF 10. The Appellants argue that there is no
18 reason to combine the references. Appeal Br. 23. But Barnett describes
19 how to implement Nichtberger's coupon computer at a different location.
20 Offering multiple venues for product promotion is and has been a
21 fundamental marketing ploy, known to those of ordinary skill in the product
22 promotion arts.

23 When there is a design need or market pressure to solve a
24 problem and there are a finite number of identified, predictable
25 solutions, a person of ordinary skill has good reason to pursue
26 the known options within his or her technical grasp. If this

leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

⁵ *KSR*, 550 U.S. at 421.

CONCLUSIONS OF LAW

7 The Examiner did not err in rejecting claims 32, 33, 35-40, 43, 45, 46,
8 48-53, 56, 58, 59, 61-66, 69, 71, and 75 under 35 U.S.C. § 102(b) as
9 anticipated by Nichtberger.

10 The Examiner erred in rejecting claims 41, 42, 44, 54, 55, 57, 67, 68,
11 and 70 and under 35 U.S.C. § 102(b) as anticipated by Nichtberger.

12 The Examiner did not err in rejecting claims 34, 47 and 60 under 35
13 U.S.C. § 103(a) as unpatentable over Nichtberger.

14 The Examiner did not err in rejecting claims 72-74 and 76 under 35
15 U.S.C. § 103(a) as unpatentable over Nichtberger and Barnett.

DECISION

17 To summarize, our decision is as follows.

18 • The rejection of claims 32, 33, 35-40, 43, 45, 46, 48-53, 56, 58, 59,
19 61-66, 69, 71, and 75 under 35 U.S.C. § 102(b) as anticipated by
20 Nichtberger is sustained.

21 • The rejection of claims 41, 42, 44, 54, 55, 57, 67, 68, and 70 under 35
22 U.S.C. § 102(b) as anticipated by Nichtberger is not sustained.

23 • The rejection of claims 34, 47 and 60 under 35 U.S.C. § 103(a) as
24 unpatentable over Nichtberger is sustained.

1 • The rejection of claims 72-74 and 76 under 35 U.S.C. § 103(a) as
2 unpatentable over Nichtberger and Barnett is sustained.
3 No time period for taking any subsequent action in connection with this
4 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

5

6 AFFIRMED-IN-PART

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9

10 mev

11

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